

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* CALI ST. JOHN

Appeal No. 2006-2377  
Application No. 09/637,242  
Technology Center 1700

Decided: August 22, 2007

Before TERRY J. OWENS, LINDA E. HORNER, and DAVID B. WALKER,  
*Administrative Patent Judges.*

OWENS, *Administrative Patent Judge*

## DECISION ON APPEAL

The Appellant appeals from a rejection of claims 1 and 3-19. The rejection of pending claim 2 is not being appealed and claim 20 has been withdrawn from consideration by the Examiner.

## THE INVENTION

The Appellant claims a method for manufacturing and applying to a  
cigarette container a protective member having advertising indicia thereon.

Claim 1 is illustrative:

1. A business method for a protective member manufacturer relating to beverage containers comprising:

the protective member manufacturer conveying by profit making sale to third party advertisers a right to attach indicia to consumer removed, flexible protective members to be adhered to beverage containers;

manufacturing the protective members;

applying indicia to the protective members; and

adhering the protective members to the containers to form a

substantially wrinkle free skin tight seal between the protective member and at least a portion of a mouth contact area of the beverage containers.

## THE REFERENCES

16	Kinoian	US 3,690,509	Sep. 12, 1972
17	Ruemer, Jr.	US 4,402,421	Sep. 6, 1983
18	Kakumu (as translated) <sup>1</sup>	JP 06-171650-A	Jun. 21, 1994
19	Miyazaki	US 5,863,624	Jan. 26, 1999
20	Dronzek, Jr.	US 5,925,208	Jul. 20, 1999
21	Takayama	US 6,015,059	Jan. 18, 2000
22	Burns	US 6,127,437	Oct. 3, 2000
23		(effective filing date on or before May 4, 1994)	
24	Bozlee	US 6,354,645 B2	Mar. 12, 2002
25		(effective filing date on or before Feb. 25, 2000)	
26	Sommers	US 6,620,281 B1	Sep. 16, 2003
27		(effective filing date Oct. 22, 1998)	

## THE REJECTIONS

30 The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1, 2, 4, 5  
31 and 12 over Kinoian in view of Bozlee; claims 3, 6, 9, 10 and 16 over Kinoian in  
32 view of Bozlee and Kakumu; claims 7 and 8 over Kinoian in view of Bozlee,

- 1 Kakumu and Burns; claims 11, 17 and 19 over Kinoian in view of Bozlee,
- 2 Kakumu, and Ruemer; claims 13 and 18 over Kinoian in view of Bozlee and
- 3 Takayama; claim 14 over Kinoian in view of Bozlee, Dronzek, and Sommers; and
- 4 claim 15 over Kinoian in view of Bozlee and Miyazaki.<sup>2</sup>

## OPINION

We affirm the aforementioned rejections.

### Rejections under 35 U.S.C. § 103

8 The Appellant groups the claims as follows: 1) claims 1, 4, 5, 7, 8 and 12,  
9 2) claims 3, 6, 9, 10 and 16, and 3) claims 11, 17 and 19 (Br. 11-12).<sup>3</sup> We  
10 therefore limit our discussion to one claim in each group, i.e., independent  
11 claims 1, 16 and 17. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

### Claim 1

13 Kinoian discloses a hygienic mouth protector (10) for a beverage can (11)  
14 (Kinoian, col. 2, ll. 45-47). The outer surface of the protector has indicia thereon  
15 for advertising or instructional purposes (Kinoian, col. 3, ll. 29-30). The protector  
16 is made of a durable plastic material such as polyethylene or polypropylene  
17 (Kinoian, col. 2, ll. 46-49). The protector can have 1) an upper portion (12) that  
18 covers approximately one-fourth of the can provided that the area covered is  
19 sufficient that after the protector has been removed from the can the upper lip of a  
20 person drinking from the can does not extend past the area that was covered, and

<sup>1</sup> The Appellants and the Examiner both incorrectly refer to Kakumu as “Kagami”.

<sup>2</sup> Claims 1-19 stand provisionally rejected under the doctrine of nonstatutory obviousness double-type patenting over the claims of application 10/360,488. Because that application has been abandoned (as of June 14, 2006), that rejection is moot.

<sup>3</sup> The Appellant does not separately argue the claims to which Burns, Takayama, Dronzek, Sommers and Miyazaki are applied.

1       2) a lower portion (13) that joins the upper portion at the rim of the can and  
2       extends downwardly sufficiently (e.g., one-third of the axial dimension of the can)  
3       that after the protector has been removed from the can the lower lip of a person  
4       drinking from the can does not extend beyond the area that was covered (Kinoian,  
5       col. 2, l. 53 – col. 3, l. 5; col. 3, ll. 54-66). Alternatively the protector may cover  
6       the can's entire top surface and the can's side in the area adjacent to the can's top  
7       (Kinoian, col. 6, ll. 35-38). Kinoian teaches that the protector also can be applied  
8       to a carton-type fluid container, in which case the protector is the same as that used  
9       on a can except that it "is shaped to conform to the corner of the carton" (Kinoian,  
10      col. 5, ll. 58-62).

11       Bozlee discloses a handle grip (10) that is made of a flat, semi-rigid sheet of  
12      a material such as cardboard, fiberboard, paperboard, Styrofoam® or plastic and is  
13      placed over the handle of a plastic shopping bag to reduce the hand discomfort of a  
14      person carrying the bag (Bozlee, col. 4, ll. 15-18; col. 5, ll. 22-25). Bozlee's  
15      handle grip "allows for unobstructed advertisement on both outside surfaces of the  
16      handle as well as on both inside surfaces of the handle" (Bozlee, col. 3, ll. 22-24).  
17      "[T]hree separate entities can advertise on a single handle device" (Bozlee, col. 3,  
18      ll. 32-33).

19       The Appellant argues that Bozlee is nonanalogous art and that, therefore, the  
20      Examiner used impermissible hindsight in rejecting the Appellant's claims (Br. 13-  
21      14).<sup>4</sup> The test of whether a reference is from an analogous art is first, whether it is  
22      within the field of the inventor's endeavor, and second, if it is not, whether it is  
23      reasonably pertinent to the particular problem with which the inventor was

---

<sup>4</sup> We do not address the Appellant's Reply Brief because the arguments therein are the same as those in the Brief.

1 involved. *See In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA  
2 1979). A reference is reasonably pertinent if, even though it may be in a different  
3 field of endeavor, it is one which, because of the matter with which it deals,  
4 logically would have commended itself to an inventor's attention in considering  
5 the inventor's problem. *See In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061  
6 (Fed. Cir. 1992). The Supreme Court's statement in *KSR Int'l. Co. v. Teleflex Inc.*,  
7 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007) that “[w]hen a work is  
8 available in one field of endeavor, design incentives and other market forces can  
9 prompt variations of it, either in the same field or a different one” indicates that for  
10 prior art to be properly applied in a rejection it need not satisfy the first prong of  
11 the nonanalogous art test. The Supreme Court also stated in *KSR* that “the problem  
12 motivating the patentee may be only one of many addressed by the patent's subject  
13 matter. The question is not whether the combination was obvious to the patentee  
14 but whether the combination was obvious to a person with ordinary skill in the  
15 art.” *KSR*, 127 S.Ct. at 1742, 82 USPQ2d at 1397. Those statements indicate that  
16 for prior art to be properly applied in a rejection it need not satisfy the second  
17 prong of the nonanalogous art test. Hence, the Appellant's argument is not well  
18 taken. Regardless, due to Bozlee's disclosure regarding advertisement on  
19 shopping bags (Bozlee, col. 3, ll. 22-33), Bozlee logically would have commended  
20 itself to the Appellant's attention in considering the problem addressed by the  
21 Appellant of developing new and innovative sites for the placement of revenue  
22 producing advertising (Spec. 5). Bozlee, therefore, is analogous art.

23 The Appellant argues that “neither reference teaches a substantially wrinkle  
24 free skin tight seal between the protective member and at least a portion of the  
25 mouth contact area of the container” (Br. 14). The protector shown in Kinoian's  
26 figures appears to be skin tight and wrinkle free. Moreover, Kinoian discloses that

1 the protector applied to a carton-type container is “shaped to conform to the corner  
2 of the carton” (Kinoian, col. 5, l. 61). Those disclosures at least would have fairly  
3 suggested, to one of ordinary skill in the art, a fit between the protector and  
4 beverage container that is substantially skin tight and wrinkle free.

5 For the above reasons we are not convinced of reversible error in the  
6 rejection of claim 1.

7 **Claim 16**

8 Kakumu discloses a beverage can’s sanitary cover seal that is made of a non-  
9 vinyl-chloride-based synthetic resin and has advertisement for a company, public  
10 institution, job, product, broadcast program, event, etc. displayed on its outer  
11 surface (Kakumu ¶ 0004). The reverse side of the seal has thereon details of the  
12 outer surface’s advertisement or adds a drawing element for a sales promotion  
13 (Kakumu ¶ 0007). The seal has 1) a circular portion shaped to match the top of the  
14 can, 2) a shallow peripheral wall (5a) that mates with the outer circumference of  
15 the can’s convex rim section (1a), and 3) a tongue-shaped piece (5b) protruding  
16 from a part of the peripheral wall (Kakumu ¶ 0006). The inner surface of the seal  
17 can be adhered to the top of the can with a peelable adhesive (Kakumu ¶ 0010).  
18 Kakumu teaches (¶ 0012) that

19 by implementing the advertising method of the present invention, consumers  
20 can enjoy the benefit of eliminating the trouble of wiping the drinking  
21 section because the sanitary cover seal covers the drinking section sanitarily;  
22 beverage manufacturers can enjoy the benefit of customer attraction by  
23 means of the sanitary cover seal while covering the cost of the sanitary cover  
24 seal with the advertisement revenue; and sponsors can implement highly  
25 effective advertisement with a novel method, and these benefits for the three  
26 parties lead to high economical effects.

27  
28 The Appellant argues that “examination of Kagami [sic, Kakumu] reveals  
29 that it is silent on an hourglass configuration to facilitate adherence to a top and

1 convex side of a container without deformation, without heat shrink application,  
2 and without wrinkling of a material protective member" (Br. 15). As correctly  
3 pointed out by the Examiner (Answer 14) the Appellant's claims are silent as to  
4 heat shrink application. The Examiner argues: "Note similarities between shape of  
5 protective member of Kagami [sic, Kakumu] and protective member of present  
6 invention as shown in Figure 4" (Answer 7). The Appellant indicates that the  
7 hourglass shape allows the protective member to be folded over a beverage can's  
8 rim without wrinkling (Spec. 16:1-5). The similarity of the shapes of the  
9 protective members of the Appellant (fig. 4) and Kakumu (fig. 3) indicates that,  
10 like the Appellant's protective member, Kakumu's protective member has an  
11 hourglass shape and, therefore, adheres to the beverage can without substantial  
12 deformation or wrinkling. Moreover, no deformation or wrinkling of the seal is  
13 shown in Kakumu's figures.

14 We therefore are not persuaded of reversible error in the rejection of claim  
15 16.

#### 16 Claim 17

17 Ruemer discloses a beverage can pull tab having on its underside  
18 promotional indicia that may indicate the award of a prize or the like (Ruemer,  
19 col. 2, ll. 23-25, 45-51, 54-56; col. 4, ll. 42-46; col. 5, ll. 41-45).<sup>5</sup>

20 The Appellant argues that "there is no reference teaching games of chance,  
21 public service announcements, and warnings" (Br. 17). What the Appellant's

---

<sup>5</sup> Such indicia also can be displayed on the underside of Kakumu's sanitary cover seal (Kakumu 6). Kakumu's disclosure that indicia is applied to both sides of the seal (Kakumu 6) would have fairly suggested, to one of ordinary skill in the art, an opaque seal that prevents the indicia on one side from being seen from the other side and thereby interfering with the visibility of the other side's indicia.

1 claim 17 recites is “such things as games of chance, premiums, collectibles,  
2 redeemables, merchandise acquisition means, and prizes”. That claim requirement  
3 is met by things such as those listed; it does not require all of them. Ruemer’s  
4 indicia indicating the award of a prize is one of those things and, therefore, meets  
5 that claim requirement.<sup>6</sup>

6 Hence, we are not convinced of reversible error in the rejection of claim 17.

7 DECISION

8 The rejections under 35 U.S.C. § 103 of claims 1, 2, 4, 5 and 12 over  
9 Kinoian in view of Bozlee, claims 3, 6, 9, 10 and 16 over Kinoian in view of  
10 Bozlee and Kakumu, claims 7 and 8 over Kinoian in view of Bozlee, Kakumu and  
11 Burns, claims 11, 17 and 19 over Kinoian in view of Bozlee, Kakumu, and  
12 Ruemer, claims 13 and 18 over Kinoian in view of Bozlee and Takayama, claim 14  
13 over Kinoian in view of Bozlee, Dronzek and Sommers, and claim 15 over Kinoian  
14 in view of Bozlee and Miyazaki are affirmed.

---

<sup>6</sup> In the event of further prosecution the Examiner and the Appellant should address on the record whether “such things as” in claim 17 renders that claim indefinite under 35 U.S.C. § 112, second paragraph.

Appeal 2006-2377  
Application 09/637,242

1           No time period for taking any subsequent action in connection with this  
2 appeal may be extended under 37 C.F.R. § 1.136(a).

3           AFFIRMED  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14       hh  
15  
16       Robert J. Van Der Wall  
17       GABLES ONE TOWER  
18       1320 South Dixie Highway  
19       Suite 1275  
20       Coral Gables, FL 33146-2926  
21